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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,395	07/24/2000	Keiko Neriishi	Q58690	6421

7590

10/21/2002

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EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/624,395

Applicant(s)

NERIISHI, KEIKO

Examiner

BJ Forman

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1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Continuation of Advisory Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 7-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of Advisory Action

1. This action is in response to papers filed 9 October 2002 in Paper No. 9 in which all independent claims (i.e. claims 7, 8, 11-14, 16 and 17) were amended.
2. The amendments will not be entered because they raise new issues which would require further search and consideration. Specifically, all pending independent claims have been amended to add the limitation "in a predetermined configuration". This new limitation has not previously been considered. Because this new limitation has been added to all independent claims, further search and consideration for all pending claims would be required.
3. Additionally, the amendments will not be entered because they potentially raise issues of new matter. Applicant points to page 10, beginning at line 15 for support. However, the cited passage merely teaches that biomolecules or detecting bodies "may be arrayed in a matrix-like form... lattice-like form or a rhombic lattice-like form". This passage does not describe a "predetermined configuration". Applicant also points to page 16, line 15 for support. The cited passage teaches that stored information "which represents which cDNA is located at which site". This passage does not teach that while the location of the cDNA is stored, it does not teach that the cDNA is arrayed in a "predetermined configuration". Because Applicant has not pointed to support in the specification for the newly added limitation, the amendments potentially raise issues of new matter.

Response to Arguments

4. Applicant argues that Shiraishi et al do not teach that their biomolecules are directly fixed on or within a phosphor sheet or protective layer. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., directly fixed or within) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

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specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims are drawn to a phosphor sheet or protective layer which has "affixed thereto" biomolecules. As stated in the Office Action, Shiraishi et al discloses the limitations of Claims 7,8, 10 and 13-15.

Applicant argues that in contrast to the method of Shiraishi et al. the instant invention wherein a target substance which hybridizes to each of the fixed biomolecules is measured and analyzed provides high sensitivity and high resolution by fixing the biomolecules directly on or within the phosphor layer or protective layer. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., measuring, analyzing, fixing biomolecules directly on or within the phosphor layer or protective layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims are drawn to a phosphor sheet or protective layer which has "affixed thereto" biomolecules, photoelectrically detecting emitted light to thereby determine the identity of a biomolecule.

Applicant further argues that Shiraishi et al does not teach that the biomolecules or detecting bodies are affixed on the phosphor layer or protective layer in a "predetermined configuration". The argument has been considered but is deemed moot in view of the fact that it addresses limitations which have not been entered.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

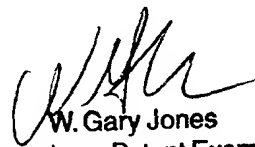
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.
Patent Examiner
Art Unit: 1634
October 21, 2002



W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600